

Remarks

The Office Action mailed March 17, 2009 has been carefully considered. No claims have been amended. Thus, Claims 1-3 and 5-11; 12-20 and 22-25; and 27, 29-43 and 45-48 remain in the case with none of the Claims currently being allowed.

As a preliminary matter, Attachment A in the December 4, 2008 Response (responding to June 6, 2008 Office Action) was submitted in error. Applicants intended to submit "Online Certifications Directory BXUV.U370, Fire Resistance Ratings – ANSI/UL 263", dated February 26, 2003, but instead submitted Online Certifications Directory BXUV.U370, Fire Resistance Ratings – ANSI/UL 263", dated November 6, 2006 (a revised version).

These documents are substantively similar, except for the dates. The former was previously submitted in the Information Disclosure Statement filed March 30, 2004. The latter is an updated version and is not prior art with respect to the February 25, 2004 filing date of the present case.

I. Rejection of Claims 1, 12, and 26 Under 35 USC §112, ¶1

Applicants disagree with the Office's position that "an area separation wall rated for two hours at about 75% design load" lacks antecedent basis in the original specification. As previously explained, the specification discusses the ANSI/UL 263 test<sup>1</sup>, which reports 75% of Design Load at 2 hours.<sup>2</sup>

Withdrawal of the rejection is respectfully requested.

<sup>1</sup> See page 1, lines 29-30.

<sup>2</sup> See page 2 of "Online Certifications Directory BXUV.U370, Fire Resistance Ratings – ANSI/UL 263", dated February 26, 2003.

**II. Rejection of Claims 1-3, 5-20, 22-27, 29-43 and 45-48 Under 35 USC §103(a)**

The Office appears to take the position that area separation walls rated for two hours at about 75% design load are known in the art because the same is disclosed in the "Online Certification Directory BXUV.U370, Fire Resistance Ratings ANSI/UL 263". However, this reference is not properly applied against the Applicants because it was neither:

- a) known or used by others before the applicants' invention; nor
- b) described in a printed publication more than one year prior to the date of the application.

Specifically, the testing reported in the "Online Certification Directory BXUV.U370, Fire Resistance Ratings ANSI/UL 263" report was **commissioned by the assignee of the application to be performed on the inventors' invention**. Accordingly, the "known or used by others" [emphasis added] requirement of 35 USC §102(a) has not been met.

Moreover, the "Online Certification Directory BXUV.U370, Fire Resistance Ratings ANSI/UL 263" does not qualify as a 35 USC §102(b) printed publication because the report is dated **February 26, 2003**, whereas the filing date of the present application is **February 25, 2004**, which is less than one year prior to the filing date of the present application.

In view of the inapplicability of "Online Certification Directory BXUV.U370, Fire Resistance Ratings ANSI/UL 263" as a reference, and the failure of Gebhardt, Mulford and ASTM E119-95a (the "Omega Reference") to teach area separation walls rated for two hours at about 75% design load, the Office has failed to establish *prima facie* obviousness.<sup>3</sup> Accordingly, withdrawal of the final rejection is respectfully requested.

<sup>3</sup> As discussed in the Response dated 12/4/08, Gebhardt does not appear to be suited for multi-level structures, and therefore does not inherently or explicitly teach 75% load bearing. Mulford walls are "slid into" building frames and do not appear to provide load bearing properties, let alone 75% load bearing. The Omega Reference does not teach 75% design load, it teaches 47.5% design load. Finally, as set forth in the previously offered Declarations of Stewart and Tumbo, 2 hours at 75% are structurally and commercially critical.

**III. Request for Withdrawal of Final Office Action**

In view of "Online Certification Directory BXUV.U370, Fire Resistance Ratings ANSI/UL 253" being improperly applied, Applicants request the finality of the current Office Action be vacated, and prosecution reopened.

For at least the reasons discussed above, Applicants believe the Office's rejections have been addressed and overcome, and earnestly solicit allowance. However, if Applicants' attorney can assist in resolving any issue, the opportunity for a telephone interview would be welcomed.

Respectfully submitted,

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